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FEB 10 2006

**OFFICE OF PETITIONS**

In re Application of  
Harris et al.  
Application No. 10/737,045  
Filed: December 16, 2003  
Attorney Docket Number: 200310972-1  
Title of Invention: System and Method for  
Power Distribution

ON PETITION

This is a decision on the petition filed December 12, 2005, under 37 CFR 1.137(a) to revive the above-identified application.

The petition to revive under 37 CFR § 1.137(a) is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR § 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely submit the issue and publication fees, as required by the Notice of Allowance and Fee (s) Due which was mailed August 30, 2005. The Notice of Allowance and Fee (s) Due set a three (3) month statutory period for reply. Extensions of time were not available under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on December 1, 2005. This decision precedes the mailing of a Notice of Abandonment.

**PETITION TO REVIVE UNDER 37 CFR § 1.137(a)**

A grantable petition under 37 CFR § 1.137(a) must be accompanied by:

- (1) the required reply,<sup>1</sup>
- (2) the petition fee,
- (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks item (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).<sup>2</sup> Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>3</sup>

Petitioner contends the delay in paying the the issue and publication fees was due to error on the part of an employee of Fulbright & Jaworski. In support, petitioner has provided a copy of a checklist and procedure for Hewlett-Packard Notice of Allowance (exhibit 1), a copy of a letter prepared in accordance with exhibit 1 (exhibit 2), the declaration of Elise Perkins, an IP secretary for Fulbright and Jaworski (exhibit 3) and a screen shot of an actions page of the docket for the above-identified application which purportedly shows an erroneous docket entry (exhibit 4). Petitioner states the secretary was responsible for preparing a letter reporting the findings and review (exhibit 2) and

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<sup>1</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

<sup>2</sup> See MPEP 711(c) (III) (c) (2) for a discussion of the requirements for a showing of unavoidable delay.

<sup>3</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

advising Hewlett-Packard the case was in condition for the issue fee to be paid. The petition and declaration of Ms. Perkins states that although Ms. Perkins drafted the requisite letter for attorney Papalas signature, Ms. Perkins failed to mail the letter to Hewlett-Packard. Further, an entry was made in the docket system which should have only been made after the mailing of the letter to Hewlett-Packard.

The petition has been considered and it has been determined that sufficient facts have not been provided to establish unavoidable delay due to a docket error.

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

As to item (A), it is noted that the Notice of Allowance and fees due was mailed to the correspondence address of record of Hewlett-Packard and not to the address of petitioner. Does Hewlett-Packard rely solely on the receipt of the letter from Fulbright & Jaworski (exhibit 2) before it pays an issue fee?

As to item (C), neither the declaration of Ms. Perkins or the petition contain enough evidence that Ms. Perkins was sufficiently trained. Ms. Perkins merely states "I have been trained or experienced to carry out the procedures enumerated on the list". On renewed petition, a statement as to specifically what type of training was provided and the type of supervision Ms. Perkins receives should be included. In an effort to establish that reliance upon Ms. Perkins was an exercise in due care, petitioner should state whether Ms. Perkins has previously failed to adhere to the requirements of the checklist.

There is no indication that the person signing the present petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the present petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

### **Alternative Venue**

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by the required reply, the required petition fee (\$750.00 for small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

The filing of a petition under 37 C.F.R. § 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 C.F.R. § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 C.F.R. § 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail:                                      Mail Stop Petition  
                                                         Commissioner for Patents  
                                                         P.O. Box 1450  
                                                         Alexandria, VA 22313-1450

By facsimile:                                (571) 273-8300

By delivery service:                      U.S. Patent and Trademark Office  
(FedEx, UPS, DHL, etc.)               Randolph Building  
                                                         401 Dulany Street  
                                                         Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at (571) 272-3215.



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